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FEE TRANSMITTAL For FY 2006

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 250.00

Complete if Known

Application Number	09/877,926
Filing Date	June 8, 2001
First Named Inventor	PAUL H. ROBB
Examiner Name	Kelly Scaggs Campen
Art Unit	3624
Attorney Docket No.	019213-0311368

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): _____

☒ Deposit Account Deposit Account Number: 033975 Deposit Account Name: PILLSBURY WINTHROP SHAW PITTMAN LLP

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1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	0.00
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180
Total Claims	Extra Claims	Fee (\$)
- 20 or HP =	x	=
HP = highest number of total claims paid for, if greater than 20.		
Indep. Claims	Extra Claims	Fee (\$)
- 3 or HP =	x	=
HP = highest number of independent claims paid for, if greater than 3.		

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets Extra Sheets Number of each additional 50 or fraction thereof Fee (\$)

- 100 = / 50 = (round up to a whole number) x 125.00 = 0.00

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): Brief in support of appeal

Fees Paid (\$)

250.00

SUBMITTED BY

Signature		Registration No. (Attorney/Agent)	58780	Telephone	703.770.7541
Name (Print/Type)	Syed J. Ali	Date	October 2, 2006		

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Appeal Brief Under 37 C.F.R. § 41.37
Attorney Docket No.: 019213-0311368
Application Serial No.: 09/877,926

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S) : Paul H. ROBB CONFIRMATION No.: 2458
SERIAL NUMBER : 09/877,926 EXAMINER: Kelly Scaggs Campen
FILING DATE : June 8, 2001 ART UNIT: 3624
FOR : METHOD AND SYSTEM FOR ENABLING COLLABORATION BETWEEN ADVISORS
AND CLIENTS

Appeal Brief Under 37 C.F.R. § 41.37

Mail Stop Appeal Brief - Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Further to the Notice of Appeal filed on **July 31, 2006**, Appellant submits this Appellant's Brief on Appeal pursuant to 37 C.F.R. § 41.37.

It is not believed that extensions of time or fees for net addition of claims are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary, then the Director is further authorized to charge any additional fees that may be due, or credit any overpayment of the same to our Deposit Account No. 033975 (**Ref. No. 019213-0311368**).

10/04/2006 MAHMED1 00000005 033975 09877926
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Appeal Brief Under 37 C.F.R. § 41.37

I. Real Party in Interest – 37 C.F.R. § 41.37(c)(1)(i)

Collaborate Solutions Inc., the assignee of the present application, is the real party in interest.

II. Related Appeals and Interferences – 37 C.F.R. § 41.37(c)(1)(ii)

Appellant is not aware of any related appeals or interferences.

III. Status of Claims – 37 C.F.R. § 41.37(c)(1)(iii)

Pending: Claims 1-59 are pending.

Cancelled: No claims have been cancelled.

Rejected: Claims 1-59 stand rejected.

Allowed: No claims have been allowed.

On Appeal: Claims 1-59 are appealed.

IV. Status of Amendments – 37 C.F.R. § 41.37(c)(1)(iv)

An After-Final amendment was filed on July 26, 2006, and the amendment was entered in the Advisory Action mailed August 28, 2006.

V. Summary of Claimed Subject Matter – 37 C.F.R. § 41.37(c)(1)(v)

The following exemplary citations to the Specification and/or drawing figures are not exclusive, as other examples of support for claimed subject matter exist. As such, the following citations should not be viewed as limiting.

Claim 1 recites a computer implemented method for enabling a financial services client and one or more financial service provider participants to collaborate as a team (e.g., Specification at 5, lines 18-20).¹ The method may comprise the steps of enabling a collaboration team comprising one or more participants to be

¹ For example, a client may have various advisors, including advisors for tax, accounting, investment, wills and estates, personal finance, or other areas. In certain instances, one or more advisors may need to be aware of changes to a client's financial situation based on action taken by other advisors. Using the collaboration tool of the invention, clients may define a level of access for various advisors, including associations between advisors, data, tasks, or other factors to account for various permutations of possible financial activity. For example, an estate planning advisor may update a will, and a tax advisor may be notified to account for any tax implications due to the updated will.

defined (e.g., Specification at 4, lines 15-17); providing a common electronic forum containing client data (e.g., Specification at 16, lines 4-13) wherein client data is accessible by one or more financial service provider participants (e.g., Specification at 5, lines 18-20) wherein each participant has predefined authorizations (e.g., Specification at 6, lines 7-8); and enabling the financial services client to interact with one or more financial service provider participants through the common electronic forum (e.g., Specification at 16, lines 13-20) wherein the common electronic forum further enables interaction among the one or more participants through the common forum (e.g., Specification at 13, lines 5-8) where client data is accessible within the scope of access authorized to each participant (e.g., Specification at 13, lines 5-8).

Claim 15 recites a computer-implemented method for enabling a financial service client and one or more financial service provider participants to collaborate as a team (e.g., Specification at 5, lines 18-20). The method may comprise the steps of enabling one or more participants to be part of a collaboration team defined by a client (e.g., Specification at 4, lines 15-17); enabling the one or more participants to access a common electronic forum containing client data (e.g., Specification at 16, lines 4-13) wherein client data is accessible by one or more financial service provider participants (e.g., Specification at 5, lines 18-20) wherein each participant has predefined authorizations (e.g., Specification at 6, lines 7-8); enabling the one or more financial service provider participants to interact with the financial services client through the common electronic forum (e.g., Specification at 16, lines 13-20); and enabling the one or more financial service provider participants to interact with each other through the common electronic forum (e.g., Specification at 44, lines 17-18) where client data is accessible within the scope of access authorized to each participant (e.g., Specification at 13, lines 5-8).

Claim 28 recites a computer implemented system for enabling a financial services client and one or more financial service provider participants to collaborate as a team (e.g., Specification at 5, lines 18-20). The system may comprise a definition means for enabling a client to define a collaboration team comprising one or more participants (e.g., Specification at 12, line 20 – 13, line 19; 34, line 17 – 36, line 6); a common electronic forum containing client data (e.g., Specification at 16, lines 4-13) wherein client data is accessible by one or more participants (e.g., Specification at 5, lines 18-20) wherein each participant is authorized a scope of

access by the client (e.g., Specification at 6, lines 7-8); and an interaction means for enabling the client to interact with one or more participants through the common forum (e.g., Specification at 12, line 20 – 13, line 19) wherein the common forum further enables interaction among the one or more participants through the common forum (e.g., Specification at 16, lines 13-20) where client data is accessible within the scope of access authorized to each participant (e.g., Specification at 13, lines 5-8).

Claim 42 recites a computer implemented system for enabling a financial services client and one or more financial service provider participants to collaborate as a team (e.g., Specification at 5, lines 18-20). The system may comprise a definition means for enabling the one or more participants to be part of a collaboration team defined by a client (e.g., Specification at 12, line 20 – 13, line 19; 34, line 17 – 36, line 6); a common electronic forum containing client data (e.g., Specification at 16, lines 4-13) wherein client data is accessible by one or more participants (e.g., Specification at 5, lines 18-20) wherein each participant is authorized a scope of access by the client (e.g., Specification at 13, lines 5-8); an interaction means for enabling the one or more participants to interact with the client through the common electronic forum (e.g., Specification at 12, line 20 – 13, line 19; 16, lines 13-20; 44, lines 17-18); and a collaboration means for enabling the one or more participants to interact with each other through the common electronic forum (e.g., Specification at 12, line 20 – 13, line 19; 44, lines 17-18) where client data is accessible within the scope of access authorized to each participant (e.g., Specification at 13, lines 5-8).

Claim 57 recites a computer-implemented method for enabling a client of more than one financial services advisor and one or more financial services advisor participants to collaborate as a team (e.g., Specification at 5, lines 18-20). The method may comprise the steps of enabling a client of more than one financial services advisor to define a financial services advisory collaboration team comprising one or more financial services advisor participants (e.g., Specification at 4, lines 15-17); and providing a common online forum for storing and selectively sharing personal and financial information about the client and financial documents associated with the client (e.g., Specification at 16, lines 4-13). The online forum may further comprise a client module that enables the client to access data

associated with the client and define data level access control for one or more financial services advisors (e.g., Specification at 16, line 4 – 17, line 21); an advisor module that enables one or more financial services advisors to select a client for which the client has previously granted the financial services advisor access to that client's data, and to select an activity related to the selected client (e.g., Specification at 18, lines 1-16); a client history database that stores data related to the client and records activity associated with the client (e.g., Specification at 23, lines 2-11); and a collaboration module that enables a client and one or more authorized financial services advisors to communicate through the online forum (e.g., Specification at 18, line 17 – 20, line 19).

VI. Grounds of Rejection to be Reviewed on Appeal – 37 C.F.R. § 41.37(c)(1)(vi)

Claims 1-59 stand rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention.

Claims 1-5, 7-19, 22-32, 34-46, 49-54, and 57-58 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,940,843 to Zucknovich et al. ("Zucknovich").

Claims 6, 20-21, 33, and 47-48 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Zucknovich in view of U.S. Patent No. 6,430,542 to Moran ("Moran").

Claims 55-56 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Zucknovich in view of U.S. Patent No. 5,787,175 to Carter ("Carter").

Claim 59 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Zucknovich in view of U.S. Patent No. 6,243,722 to Day et al. ("Day").

Appellant notes the provisional rejection of claims 1-59 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-37 of copending Application No. 09/732,008.

Although Appellant disagrees with the provisional double-patenting rejections set forth by the Examiner, Appellant will not address these provisional rejections in the Appeal Brief. Rather, Appellant will file a terminal disclaimer upon the indication of allowable subject matter. Appellant further notes that no claims have been indicated as allowable in copending Application No. 09/732,008, and that the filing of a terminal disclaimer to obviate a rejection based on non-statutory double patenting is not an admission of the propriety of the rejection. *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870 (Fed. Cir. 1991) (“filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection.”).

VII. Argument – 37 C.F.R. § 41.37(c)(1)(vii)

A. The rejections of claims 1-59 under 35 U.S.C. § 112, second paragraph should be reversed because the claims are clear and definite.

Claims 1-59 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention. In particular, in the Final Office Action mailed January 30, 2006 (“Final Office Action”) the Examiner alleges, “there is no definition of the meets *[sic]* and bounds” for the following claim terms: “collaborate,” “enabling,” “to interact,” “forum,” “events,” and “actions.” Final Office Action at 2. This rejection is legally improper and should be reversed because the claims meet the requirements of clarity and precision required under § 112, second paragraph.

Each of these terms are fairly common terms, and should be well understood alone or clearly in the context of the Specification. Even if it were true that these are not commonly understood terms, they are not indefinite, as a “fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose.” MPEP § 2173.01. Moreover, it has long been the law that a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought. *Id.*

Insofar as § 112, second paragraph is concerned, the question is not whether more suitable language or modes of expression are available, but rather, whether the claim meets threshold requirements of clarity and precision. MPEP § 2173.02. For at least the reason that the claims meet these threshold requirements in their present form, the rejections under § 112, second paragraph are improper should be reversed.

Although Appellants submit that the claims are sufficiently clear on their face, exemplary citations to the Specification have been provided to further demonstrate that the scope of the challenged claim terms would be discernable to a person having ordinary skill in the art. The following recitations and citations to the Specification are exemplary only and should not be viewed as limiting. For example, a team of advisors and clients may “collaborate” as a cohesive team in sharing information, devising a plan, addressing client concerns, or performing other collaborative tasks.² Specification at 4-5. The invention may “enable” a client (or other participants) to authorize selected advisors (or other participants) to view, discuss, modify, and perform other operations on behalf of clients. Specification at 4. For example, the client (or other participants) may grant rights to access certain documents, “enabling” that entity to view or interact with the document. The advisors (or other participants) may “interact” with clients by using a collaboration tool to communicate and otherwise serve the client in a coordinated manner. Specification at 5. Clients (or other participants) may use the collaboration tool to create a “forum” that contains documents (or other client data) where a particular advisor (or set of advisors) may control, maintain, and organize work. Specification at 54. Clients (or other participants) may define personalized alerts for defining “events,” where a notification may be sent in response to a particular action. Specification at 17. For example, an “action” may be defined as an advisor, client, or other participant viewing, editing, or performing other operations. Specification at 17. Thus, because a person having ordinary skill in the art would be able to identify

² For example, it is common for a client to have several financial advisors with distinct specialties. However, the roles of the various financial advisors are likely to overlap to some extent, wherein they may consider similar financial data or may provide advice based on implications of the actions of other advisors. The collaboration tool of the invention thus provides a solution for teams of advisors to work together for a common client by sharing resources and information, as well as facilitating communication amongst distinct entities. For example, what a trust and estate attorney may do for a client may implicate a need for the client’s tax advisor to participate in the planning.

the meaning of the claim terms, when viewed in light of the Specification, the claim terms are definite and meet the requirements of § 112, second paragraph. For at least this reason, the rejections under § 112, second paragraph are improper and should be reversed.

The Examiner also alleges that the terms “clients” and “participants” are “confusing since the relationship between the two is not recited.” Final Office Action at 2. This assertion is without merit and legally improper. For example, referring to claim 1, it is clearly provided that “a financial services client and one or more financial service providers . . . collaborate as a team.” The relationship between “clients” and “participants” is clearly defined by the plain language of the claim, in that the preamble of claim 1 defines the relationship between “clients” and “participants” (i.e., they exist as a collaboration team), and the body of the claim provides examples of how “clients” and “participants” may collaborate. For at least this reason, the rejections under § 112, second paragraph are improper and should be reversed.

The Examiner also alleges that the claim term of “library of resources” is “vague and indefinite since the entire Internet could be defined as such.” Final Office Action at 2. This assertion is also legally improper, as the Examiner is attaching a meaning to the term “library of resources” that directly contradicts the meaning provided in the Specification. For example, a “library of resources” is discussed in the Specification as an extensive research and online content library that may provide exhaustive, in depth financial and other information on a wide variety of planning, investment, advisory, or other topics. Specification at 68-70. Moreover, even assuming *arguendo* that a “library of resources” could constitute the “entire Internet,” the Examiner has failed to establish that such a meaning would be vague and/or indefinite. For at least this reason, the rejections under § 112, second paragraph are improper and should be reversed.

The Examiner also alleges that the “recitations of claims 4 and 18 are confusing as a whole because the interrelationships claimed are not clear.” Final Office Action at 2. Claims 4 and 18 contain similar language reciting “wherein the common forum provides modification information associated with client data wherein modification information comprises one or more actions associated with one or more participants.” Appellant submits that this language is sufficiently clear on its face,

and more so when read in light of the Specification. In particular, the invention enables clients (or other participants) to define modification information for various client data, wherein the modification information defines one or more actions that a participant may take on the client data. Specification at 54 ("The shared folder may be set up by the client, and the permissions may be granted . . . to any advisor that needs to move documents to that folder"); Specification at 62 ("each advisor may perform the activities which are native to their specialty."). Thus, for at least the reason that a person having ordinary skill in the art would be able to discern the boundaries of claims 4 and 18, the rejections under § 112, second paragraph are improper and should be reversed.

Finally, the Examiner alleges that claims 28-54 are indefinite because a "system" is "vague and indefinite since a system may be one of several statutory classes of invention." Final Office Action at 2-3. Moreover, the Examiner alleges, "Applicant must indicate on the record what statutory class of invention the system claims belong to." *Id.* Appellant submits that this rejection is without proper basis and is legally improper. The term "system" is routinely used in patent claims without rejection, and no legal basis has been provided for this position. Even if the system of claims 28-54 are interpreted as functional limitations, "[t]here is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper." MPEP § 2173.05(g). For at least the reason that a person having ordinary skill in the art would be able to identify the boundaries of claims 28-54, including the relevant statutory class of invention, the rejections under § 112, second paragraph are improper and should be reversed.

B. The rejections of claims 1-59 under 35 U.S.C. § 103 should be reversed because the Examiner has failed to establish a *prima facie* case of obviousness.

Claims 1-5, 7-19, 22-32, 34-46, 49-54, and 57-58 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,940,843 to Zucknovich et al. ("Zucknovich"); claims 6, 20-21, 33, and 47-48 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Zucknovich in view of U.S. Patent No. 6,430,542 to Moran ("Moran"); claims 55-56 stand rejected under 35

U.S.C. § 103(a) as allegedly being unpatentable over Zucknovich in view of U.S. Patent No. 5,787,175 to Carter ("Carter"); and claim 59 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Zucknovich in view of U.S. Patent No. 6,243,722 to Day et al. ("Day").

Appellant submits that these rejections are legally improper, and should be reversed, for at least the reason that the Examiner has failed to meet the burden of establishing a *prima facie* case of obviousness. In particular, the references relied upon by the Examiner, either alone or in combination with another, fail to disclose, teach, or suggest all the features of the claimed invention. More particularly, Zucknovich fails to disclose, teach, or suggest at least the feature of "providing a common electronic forum containing client data wherein client data is accessible by one or more financial service provider participants wherein each participant has predefined authorizations," as recited in claim 1, for example. The Examiner appears to rely upon Zucknovich at col. 5, lines 60-67 as teaching the claimed "client" and "client data," and col. 6, lines 25-30 as teaching the claimed "participant [having] predefined authorizations."

Zucknovich is a fundamentally different system and addresses different problems from that of the claimed invention. Zucknovich generally relates to research contributors and reports generated by the research contributors, wherein the reports are distributed to investors.³ Thus, the cited portions of Zucknovich do not relate to "a common electronic forum containing client data . . . accessible by one or more financial service provider participants wherein each participant has predefined authorizations." In particular, the research reports identified by the Examiner cannot be reasonably considered "client data," as the claimed invention recites enabling collaboration between clients and participants by authorizing participants to access "client data." That is, the "client data" recited in claim 1 is specific to a client, and participants may be authorized to access the client data. Assuming *arguendo* that the research contributors and investors described by Zucknovich can be considered similar to the claimed "clients" and "participants," the

³ In contrast to the claimed invention, Zucknovich does not provide collaboration between clients and a team of advisors. Rather, Zucknovich is directed to distribution of research reports to a central repository and regulating access to the reports. There is no collaboration between research contributors and the eventual recipients of the reports, nor do the research contributors collaborate with each other on behalf of a common client.

content of the research reports concerns third parties, rather than the investors or research contributors. Because the content of the reports describe neither the research contributors nor the recipients of the report, the reports cannot be reasonably considered "client data." This is made clear from the Background section of Zucknovich, which describes third party financial research firms as being entities that deliver information regarding public companies to investors. That is, the content of the research pertains to third parties, and thus is clearly not "client data," as alleged by the Examiner. For at least this reason, the rejection is improper, as Zucknovich does not disclose, teach, or suggest this feature of claim 1. Moran, Carter, and Day fail to cure the deficiencies of Zucknovich with respect to claim 1. Claims 15, 28, 42, and 57 contain similar features as those recited in claim 1. Dependent claims 2-14, 16-27, 29-41, 43-56, and 58-59 depend from and add features to one of claims 1, 15, 28, 42, and 57. For at least these reasons, the rejections of claims 1-59 under § 103 are improper and should be reversed.

The rejections under § 103 are also legally improper because Zucknovich fails to disclose, teach, or suggest "enabling the financial services client to interact with one or more financial service providers through the common electronic forum," as recited in claim 1, for example. The Examiner appears to identify Zucknovich at col. 8, lines 14-50 as allegedly teaching this feature. However, the cited portions of Zucknovich merely describe an investor logging into a web site to download research reports, such that there is no interaction between parties in Zucknovich. In Zucknovich, research contributors independently generate research reports and submit the reports to a central repository (col. 5, lines 59-65; col. 6, lines 17-39; col. 6, lines 60-67). The research contributors generate the reports independently of investors, and once the research reports are stored in the central repository, the contributors role is complete. Zucknovich discloses that investors may later log into the web site to download the reports if they do not have restricted access (col. 7, lines 48-61; col. 8, lines 15-62).

There is no communication or "interaction" between the investors and contributors, whereas claim 1 recites "enabling the financial services client to interact with one or more financial service provider participants through the common electronic forum." The Examiner acknowledges that Zucknovich does not disclose, teach, or suggest a collaboration forum, but nonetheless alleges that such a

teaching would have been obvious because Zucknovich allegedly teaches “that research provides require interaction with those who desire their work product.” Final Office Action at 4. The Examiner appears to identify col. 1, lines 39-44 as support for this allegation. *Id.* However, the Examiner’s assertion is factually erroneous, and fails to establish obviousness, because the cited portions of Zucknovich do not discuss interaction between research providers and those who access their work product, but rather, controlling access to the research reports. At best, regulating access to the reports is a security measure rather than interaction. For at least this reason, Zucknovich does not disclose, teach, or suggest this feature of claim 1, as alleged by the Examiner. Moran, Carter, and Day fail to cure the deficiencies of Zucknovich with respect to claim 1. Claims 15, 28, 42, and 57 contain similar features as those recited in claim 1.

Dependent claims 2-14, 16-27, 29-41, 43-56, and 58-59 depend from and add features to one of claims 1, 15, 28, 42, and 57. In addition, the Examiner has failed to provide any evidence to support a rejection for many of the dependent claims. For example, Zucknovich does not disclose, teach, or suggest at least the feature of “wherein the common forum provides modification information associated with client data wherein modification information comprises one or more actions associated with one or more participants,”⁴ as recited in claim 4, for example. See Final Office Action at 3-4.

For at least these reasons, the rejections of claims 1-59 under § 103 are improper and should be reversed.

C. The rejections of claims 1-59 under 35 U.S.C. § 103 should be reversed because the Examiner has relied upon non-analogous prior art.

In addition to failing to disclose, teach, or suggest several features of the claimed invention, the Examiner has failed to meet the burden of establishing that Zucknovich (the primary reference in all of the § 103 rejections) is analogous art. More particularly, “in order to rely on a reference as a basis for rejection of an

⁴ For example, certain financial advisors may only need access to certain documents, and the collaboration tool of the invention enables clients (or other participants) to define what a particular advisor (or set of advisors) is authorized to modify. The collaboration tool may provide a forum to store any number of client documents or other data, and each advisor may be authorized to view some or all of the documents or data as needed for that advisor’s tasks and responsibilities.

applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then reasonably pertinent to the particular problem with which the inventor was concerned." MPEP § 2141.01(a).

In the instant case, Zucknovich's field of endeavor is the electronic distribution of research reports to authorized recipients, and the particular problem addressed therein is allowing a research provider to filter or restrict opinions and reports, or somehow indicate to clients and investors that a company is under review. In contrast, the field of endeavor of the present invention is collaboration between advisors, clients, and/or other participants, and the particular problem is regulating access to client data, exchanging data with participants, and communicating between clients and advisors to achieve consistent and accurate collaboration of resources and information. Because the content of research reports in Zucknovich is related to third parties (i.e., unrelated to the recipients of the reports), and because Zucknovich is not concerned with collaboration between the research contributors and investors, Zucknovich is in a distinct field of endeavor from the claimed invention, as well as being directed to a distinct problem from that addressed by Appellant.

In response to previous arguments challenging Zucknovich as non-analogous art, the Examiner has responded by alleging that Zucknovich "is capable of performing the function of the instant application regardless of whether it is a financial service provider or other type of service provider is irrelevant [*sic*]." Final Office Action at 8. The Examiner has failed to establish that Zucknovich is analogous art because the Examiner has not provided any evidence of Zucknovich being in Appellant's field of endeavor or reasonably pertinent to the problem addressed by Appellant. Moreover, whether or not the reference is "capable of performing the function of the instant application" is irrelevant with respect to the question of whether the reference is analogous art. In particular, by alleging that the roles of clients and participants is irrelevant, the Examiner has stripped the "field of endeavor" test of any significance. In addition, the Examiner's assertion that Zucknovich is capable of performing the function of the instant invention is contrary to logic and factually erroneous. No evidence has been provided to show that Zucknovich teaches or suggests collaboration that would enable an exchange of

data. For at least these reasons, Zucknovich is directed to non-analogous art, and each of the rejections based thereon must fail.

VIII. Claims Appendix – 37 C.F.R. § 41.37(c)(1)(viii)

The pending claims (claims 1-59) are attached in **Appendix A**.

IX. Evidence Appendix – 37 C.F.R. § 41.37(c)(1)(ix)

Appendix B: None.

X. Related Proceedings Appendix – 37 C.F.R. § 41.37(c)(1)(x)

Appendix C: None.

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Conclusion

For at least the foregoing reasons, Appellants respectfully submit that the present claims are clear and definite, as well as being allowable over the cited prior art references. Reversal of the rejections is respectfully requested.

Date: October 2, 2006

Respectfully submitted,

By:



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Appendix A: Claims Appendix

1. A computer implemented for enabling a financial services client and one or more financial service provider participants to collaborate as a team comprising the steps of:

enabling a collaboration team comprising one or more participants to be defined;

providing a common electronic forum containing client data wherein client data is accessible by one or more financial service provider participants wherein each participant has predefined authorizations; and

enabling the financial services client to interact with one or more financial service provider participants through the common electronic forum wherein the common electronic forum further enables interaction among the one or more participants through the common forum where client data is accessible within the scope of access authorized to each participant.

2. The method of claim 1 wherein participants comprise advisors.

3. The method of claim 1 wherein the common forum provides download capability of client data.

4. The method of claim 1 wherein the common forum provides modification information associated with client data wherein modification information comprises one or more actions associated with one or more participants.

5. The method of claim 1 further comprising the step of enabling the client to view information associated with the one or more participants collaborating for the client wherein information comprises one or more of participant identification, historical information, scope of access and activity information for each participant.

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6. The method of claim 1 further comprising the step of enabling the client to access a calendar function for collaborating events with one or more participants associated with the client.
7. The method of claim 1 further comprising the step of enabling the client to view aggregated client data from one or more sources.
8. The method of claim 1 further comprising the step of enabling the client to access a library of resources.
9. The method of claim 1 wherein client data comprises financial documents.
10. The method of claim 1 wherein participants comprise financial advisors associated with the client.
11. The method of claim 1 further comprising a step of enabling the client to access a client history database wherein the client history database maintains information related to previous actions.
12. The method of claim 1 further comprising a step of enabling the client to access a client history database wherein the client history database maintains information related to previous actions.
13. The method of claim 1 wherein client access comprises one or more of read only; read and write; read, write and delete; and no access.
14. The method of claim 1 further comprising a step of enabling the client to add a new participant.
15. A computer-implemented method for enabling a financial service client and one or more financial service provider participants to collaborate as a team comprising the steps of:

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enabling one or more participants to be part of a collaboration team defined by a client;

enabling the one or more participants to access a common electronic forum containing client data wherein client data is accessible by one or more financial service provider participants wherein each participant has predefined authorizations;

enabling the one or more financial service provider participants to interact with the financial services client through the common electronic forum; and

enabling the one or more financial service provider participants to interact with each other through the common electronic forum where client data is accessible within the scope of access authorized to each participant.

16. The method of claim 15 wherein participants comprise advisors.

17. The method of claim 15 wherein the common forum provides download capability of client data.

18. The method of claim 15 wherein the common forum provides modification information associated with client data wherein modification information comprises one or more actions associated with one or more participants.

19. The method of claim 15 further comprising the step of enabling the one or more participants to view information associated with the client for whom the one or more participants are collaborating.

20. The method of claim 15 further comprising the step of enabling the one or more participants to access a calendar function for collaborating events with other participants associated with the client and the client.

21. The method of claim 15 further comprising the step of enabling the one or more participants to formulate a financial plan for the client based on aggregated client data from one or more sources.

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22. The method of claim 15 further comprising the step of enabling the one or more participants access a library of resources wherein information gathered from the library of resources are imported into the common forum for the client.

23. The method of claim 15 wherein client data comprises financial documents.

24. The method of claim 15 wherein participants comprise financial advisors associated with the client.

25. The method of claim 15 further comprising a step of enabling the one or more participants to define one or more triggering events and one or more alert mechanisms for notifying the one or more participants of the occurrence of the one or more triggering events.

26. The method of claim 15 further comprising a step of enabling the one or more participants access to a client history database wherein the client history database maintains information related to previous actions.

27. The method of claim 15 further comprising a step of enabling the one or more participants to add a new client.

28. A computer implemented system for enabling a financial services client and one or more financial service provider participants to collaborate as a team comprising:

a definition means for enabling a client to define a collaboration team comprising one or more participants;

a common electronic forum containing client data wherein client data is accessible by one or more participants wherein each participant is authorized a scope of access by the client; and

an interaction means for enabling the client to interact with one or more participants through the common forum wherein the common forum further enables

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interaction among the one or more participants through the common forum where client data is accessible within the scope of access authorized to each participant.

29. The system of claim 28 wherein participants comprise advisors.

30. The system of claim 28 wherein the common forum provides download capability of client data.

31. The system of claim 28 wherein the common forum provides modification information associated with client data wherein modification information comprises one or more actions associated with one or more participants.

32. The system of claim 28 further comprising a display means for enabling the client to view information associated with the one or more participants collaborating for the client wherein information comprises one or more of participant identification, historical information, scope of access and activity information for each participant.

33. The system of claim 28 further comprising a calendar function for collaborating events with one or more participants associated with the client.

34. The system of claim 28 further comprising a display means for enabling the client to view aggregated client data from one or more sources.

35. The system of claim 28 further comprising a resource means for enabling the client to access a library of resources.

36. The system of claim 28 wherein client data comprises financial documents.

37. The system of claim 28 wherein participants comprise financial advisors associated with the client.

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38. The system of claim 28 further comprising an alert means for enabling the client to define one or more triggering events and one or more alert mechanisms for notifying the client of the occurrence of the one or more triggering events.

39. The system of claim 28 further comprising a client history database for maintaining information related to previous actions.

40. The system of claim 28 wherein client access comprises one or more of read only; read and write; read, write and delete; and no access.

41. The system of claim 28 further comprising an add means for enabling the client to add a new participant.

42. A computer implemented system for enabling a financial services client and one or more financial service provider participants to collaborate as a team comprising:

a definition means for enabling the one or more participants to be part of a collaboration team defined by a client;

a common electronic forum containing client data wherein client data is accessible by one or more participants wherein each participant is authorized a scope of access by the client;

an interaction means for enabling the one or more participants to interact with the client through the common electronic forum; and

a collaboration means for enabling the one or more participants to interact with each other through the common electronic forum where client data is accessible within the scope of access authorized to each participant.

43. The system of claim 42 wherein participants comprise advisors.

44. The system of claim 42 wherein the common forum provides download capability of client data.

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45. The system of claim 42 wherein the common forum provides modification information associated with client data wherein modification information comprises one or more actions associated with one or more participants.

46. The system of claim 42 further comprising a display means for enabling the one or more participants to view information associated with the client for whom the one or more participants are collaborating.

47. The system of claim 42 further comprising a calendar function for collaborating events with other participants associated with the client and the client.

48. The system of claim 42 further comprising a planning means for enabling the one or more participants to formulate a financial plan for the client based on aggregated client data from one or more sources.

49. The system of claim 42 further comprising a resource means for enabling the one or more participants access a library of resources wherein information gathered from the library of resources are imported into the common forum for the client.

50. The system of claim 42 wherein client data comprises financial documents.

51. The system of claim 42 wherein participants comprise financial advisors associated with the client.

52. The system of claim 42 further comprising an alert means for enabling the one or more participants to define one or more triggering events and one or more alert mechanisms for notifying the one or more participants of the occurrence of the one or more triggering events.

53. The system of claim 42 further comprising a client history database for maintaining information related to previous actions.

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54. The system of claim 42 further comprising an add means for enabling the one or more participants to add a new client.

55. The method of claim 1, wherein the client data contained in the common forum is stored in an encrypted format.

56. The method of claim 1, further comprising the step of providing a means to transmit the client data to the common forum in an encrypted format.

57. A computer-implemented method for enabling a client of more than one financial services advisor and one or more financial services advisor participants to collaborate as a team comprising the steps of:

enabling a client of more than one financial services advisor to define a financial services advisory collaboration team comprising one or more financial services advisor participants; and

providing a common online forum for storing and selectively sharing personal and financial information about the client and financial documents associated with the client, the online forum further comprising:

a client module that enables the client to access data associated with the client and define data level access control for one or more financial services advisors;

an advisor module that enables one or more financial services advisors to select a client for which the client has previously granted the financial services advisor access to that clients data, and to select an activity related to the selected client;

a client history database that stores data related to the client and records activity associated with the client; and

a collaboration module that enables a client and one or more authorized financial services advisors to communicate through the online forum.

58. The computer implemented method of claim 57 wherein the client module further comprises:

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an action request module that enables a client to request one or more financial services advisors to update one or more of the client's files; and

a program alert module that enables the client to define personalized alerts in response to triggering events defined by the client.

59. The computer implemented method of claim 57 wherein the collaboration module further comprises:

a document view module that enables a client and one or more authorized financial services advisors to view and edit one or more documents related to the client that are stored in a central repository;

an update module that enables the client and one or more financial services advisors to view a summary of modifications performed relative to one or more documents; and

a chat board that enables the client and one or more financial services advisors to engage in a real time online conference.

Amendment dated: July 26, 2006

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Appendix B: Evidence Appendix

NONE

Amendment dated: July 26, 2006

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Appendix C: Related Proceedings Appendix

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